

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES R. PETTINGELL

Appeal No. 95-5103
Application No. 08/074,303¹

ON BRIEF

Before FRANKFORT, STAAB, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 4, 6 and 7, which are all of the claims pending in this application.²

¹ Application for patent filed June 9, 1993.

² Claim 1 was amended subsequent to the final rejection. Claim 5 was canceled subsequent to the final rejection.

Appeal No. 95-5103
Application No. 08/074,303

We REVERSE.

BACKGROUND

The appellant's invention relates to a glass article forming machine. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Farkas	4,338,115	July 6,
1982		

Claims 1 through 4, 6 and 7 stand rejected under 35
U.S.C.

§ 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims 1, 6 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Farkas.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 16, mailed June 5, 1995) for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 13, filed March 2, 1995) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness issues

We will not sustain the examiner's rejection of claims 1 through 4, 6 and 7 under 35 U.S.C. § 112, second paragraph.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). That is, claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available.

Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented cannot be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is appropriate.

Thus, the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. As stated above, if the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. See Ex parte Porter, 25 USPQ2d 1144, 1146 (Bd. Pat. App. & Inter. 1992).

With this as background, we turn to the specific rejection under 35 U.S.C. § 112, second paragraph, made by the examiner of the claims on appeal. The examiner determined (answer, p. 4) that

(1) There is no antecedent basis for "said first and second enabled start buttons", claim 1 at lines 14-15.

(2) Claim 1 is incomplete because the necessary structural cooperative relationship of the elements is omitted; MPEP 706.03(f)^[3]. In particular, the depressible start buttons and the means for enabling need not be [sic, are not] related in any fashion to the rest of the apparatus. Lines 13-15 of claim 1 merely requires that the regulators are capable of working when the start buttons are depressed.

The appellant argues (brief, pp. 3-5) that the examiner's reasons for rejecting claim 1 as being indefinite are in error. We agree. In our view, the examiner has not met his burden of pointing out specifically how claim 1 fails to define the metes and bounds of the claimed invention with a reasonable degree of precision and particularity. In that regard, it is our opinion that an artisan would know that the phrase "said first and second enabled start buttons" is referring back to the first and second depressible start buttons previously claimed which have been enabled by the previously claimed "means for enabling said first and second depressible start buttons." In addition, we see no basis for rejecting claim 1 as being incomplete since the mere breadth

³ Section 706.03(f) was deleted from the MPEP in September 1995 (6th Edition, Revision 1).

of a claim does not in and of itself make a claim indefinite.⁴
In any event, it is our view that claim 1 does set forth a
cooperative relationship of the elements recited.

The obviousness issue

We will not sustain the examiner's rejection of claims 1,
6 and 7 under 35 U.S.C. § 103.

Obviousness is established by presenting evidence that
the reference teachings would appear to be sufficient for one
of ordinary skill in the relevant art having the teachings
before him to arrive at the claimed invention. See In re
Lintner, 9 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972) and
In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed.
Cir. 1988).

The examiner determined (answer, p. 4) that the only
difference between Farkas and claim 1 was that "Farkas fails

⁴ Breadth of a claim is not to be equated with
indefiniteness. See In re Miller, 441 F.2d 689,, 169 USPQ 597
(CCPA 1971).

to disclose what type of switches are used [toggle switches]."
The examiner then determined (answer, p. 5) that it would have been obvious to use toggle switches since toggle switches are well known, inexpensive and easy to install.

The appellant has not contested the examiner's position with respect to the above-noted modification of Farkas. Instead the appellant has contested the examiner's determination that Farkas only lacked the claimed toggle switches. Specifically, the appellant argues (brief, pp. 5-7) that Farkas does not disclose (1) first and second depressible start buttons, and (2) means for enabling said first and second depressible start buttons.

The examiner responded to the appellant's argument by noting that (1) the appellant's specification does not describe what is meant by the various "means-plus-function" limitations (answer, p. 9); (2) Farkas discloses a normally open push-button start switch 35 and that it is clear that Farkas requires two such buttons (answer, p. 6); and (3) wires

which are connected to the buttons are the claimed "means for enabling" (answer, p. 6).

Initially we note that if the examiner believes that the appellant's specification does not describe what is meant by the various "means-plus-function" limitations recited in the claims under appeal, he should make a rejection under 35 U.S.C. § 112, second paragraph. As explained in In re Donaldson Co., 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848-49 (Fed. Cir. 1994), the PTO may not disregard the structure disclosed in the specification corresponding to "means-plus-function" language when rendering a patentability determination. The court in Donaldson agreed with the general principle espoused in In re Lundberg, 244 F.2d 543, 547-48, 113 USPQ 530, 534 (CCPA 1957), that the sixth paragraph of section 112 does not exempt an applicant from the requirements of the first two paragraphs of that section. Although paragraph six statutorily provides that one may use means-plus-function language in a claim, one is still subject to the requirement that a claim "particularly point out and distinctly claim" the invention. Therefore, if one employs

"means-plus-function" language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112. Donaldson, 16 F.3d at 1195, 29 USPQ2d at 1850. See also In re Dossel, 115 F.3d 942, 946-47, 42 USPQ2d 1881, 1884-85 (Fed. Cir. 1997).

We agree with the appellant that there is no teaching in Farkas that a normally open push-button start switch 35 is provided in both section 15 and section 16. Nevertheless, clearly Farkas teaches that consoles 22 and 23 are each provided with a machine start switch (not shown) for switching the individual section from the safe condition to the run condition and a machine stop switch (not shown) for switching the individual section from the run condition to the safe condition.⁵ In our view, it would have been obvious to make

⁵ See column 4, lines 26-42, of Farkas.

such switches push-button, for self-evident reasons.
Accordingly, the claimed first and second depressible start buttons would have been obvious from the teachings of Farkas.

We agree with the appellant the claimed "means for enabling said first and second depressible start buttons" is not readable on wires as determined by the examiner. Elements expressed in "means-plus-function" format are interpreted under 35 U.S.C.

§ 112, paragraph 6⁶, to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. In this case, the appellant has disclosed (specification, p. 4) that the system is enabled by pushing/depressing the override enable button 45 shown on the control panel 32 in Figure 3. Thus, the structure described

⁶ 35 U.S.C. § 112, sixth paragraph, states:
An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

in the specification as corresponding to the claimed "means for enabling said first and second depressible start buttons" is a depressible push button. In our view, clearly wires are not an equivalent to a depressible push button. Thus, all the limitations of claim 1 are not suggested or taught by Farkas.

Since all the limitations of claim 1 are not suggested or taught by Farkas, the decision of the examiner to reject claim 1, and claims 6 and 7 dependent thereon, under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 4, 6 and 7 under 35 U.S.C. § 112, second paragraph, is reversed and the decision of the examiner to reject claims 1, 6 and 7 under 35 U.S.C. § 103 is reversed.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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APPEAL NO. 95-5103 - JUDGE NASE
APPLICATION NO. 08/074,303

APJ NASE

APJ STAAB

APJ FRANKFORT

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 04 Jan 99

FINAL TYPED: